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EXAMINER

COUGHLAN, PETER D

ART UNIT

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY W. WHITE and JAMES HUNTER ENIS

Appeal 2009-005293
Application 10/696,942
Technology Center 2100

Before: JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and JEAN R.
HOMERE, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to a solution network excursion module.
(Title) Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for identifying excursions to general solutions provided by a solution network comprising:
 - identifying excursions to a general solution on a system model basis;
 - saving the excursions within the solution network on a system model basis;
 - when accessing the solution network, searching the solution network to determine whether an excursion solution exists; and,
 - presenting support knowledge to a customer based upon the accessing, the support knowledge including the excursion solution when the excursion solution exists.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ferguson	US 2003/0130899 A1	Jul. 10, 2003
Markham	US 2003/0158795 A1	Aug. 21, 2003
Collins	US 2004/0243998 A1	Dec. 2, 2004

REJECTIONS

Claims 1, 8, 9, 16, 17, and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ferguson. Ans. 3.

Claims 2-4, 10-12, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferguson and Collins. Ans. 7.

Claims 5-7, 13-15, and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferguson and Markham. Ans. 9.

ISSUES

Has the Examiner erred in rejecting independent claims 1, 9, and 17 under 35 U.S.C. § 102(e)? Specifically, have Appellants set forth specific arguments for patentability for these claims over the Examiner's showing of anticipation over the Ferguson reference?

PRINCIPLES OF LAW

35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

What a reference teaches is a question of fact. *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994)

35 U.S.C. § 103(a)

Obviousness requires that all limitations be taught or suggested by the reference or references.

ANALYSIS

It is our view that Appellants have generally alleged in the Brief that the above-mentioned claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes over the cited references. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 CFR § 41.37(c)(1)(vii). We find Appellants' appeal is based on a series of conclusory arguments presented in the Brief. This form of argument is ineffective in establishing the patentability of the claims on appeal. *See Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative). Available at: <http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf>

The Examiner further responded to Appellants' general allegations and further detailed and buttressed the statement of the rejection in the Response to Argument. (Ans. 11-15). Appellants failed to file a Reply Brief to further address the merits of the Examiner's original statement of the ground of the rejection or the Response to Argument. Weighing as a whole the Appellants' arguments, which are not supported by further explanation, that the elements are missing against the Examiner's specific and detailed findings, we reach a conclusion that Appellants have not shown error in the Examiner's finding of anticipation and obviousness. Appellants

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have provided no separate arguments for patentability and all the dependent claims under 35 U.S.C. § 102 will fall with their respective independent claims.

35 U.S.C. § 103

Appellants have provided no separate arguments for patentability and all the dependent claims under 35 U.S.C. § 103 will fall with their respective independent claims.

CONCLUSION OF LAW

The Examiner did not err in rejecting independent claim 1, 9, and 17 under 35 U.S.C. § 102(e).

DECISION

For the above reasons, the Examiner's rejection of claims 1, 8, 9, 16, 17, and 24 under 35 U.S.C. § 102(e) is affirmed and the Examiner's rejection of claims 2-7, 10-15, and 18-23 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

tkl

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